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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,688	09/30/2003	David J. Park	66329/31349	6172
23380 7590 02/26/2008 TUCKER ELLIS & WEST LLP 1150 HUNTINGTON BUILDING 925 EUCLID AVENUE CLEVELAND, OH 44115-1414			EXAMINER ROBINSON, MYLES D	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 02/26/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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patents@tuckerellis.com
mary.erne@tuckerellis.com

Office Action Summary	Application No. 10/675,688	Applicant(s) PARK ET AL.	
	Examiner Myles D. Robinson	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/30/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The examiner has considered the references listed in the Information Disclosure Statement (IDS) submitted on 9/30/2003 (see attached PTO-1449).

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference characters 100 (*page 4, line 2*), 200 (*page 5, line 3*), 500 (*page 5, line 27*) and 600 (*page 6, line 3*). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. The following quotation of 37 CFR 1.75(a) is the basis of the objection:
 - (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

4. **Claims 1 – 32** are objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery.

Claims 1, 9, 17 and 25 recite the limitation “a paper document” (line 11 of claim 1, line 8 of claim 9, line 12 of claim 17 and line 10 of claim 25) after the limitation “a paper document” was claimed in line 3 of claims 1, 17 and 25 and in line 2 of claim 9. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** “paper document” or ***a unique and distinctly different*** “paper document” within these claims. All claims dependent upon these claims suffer the same deficiency and, therefore, are objected to as well.

5. **Claims 3, 11, 19 and 27** recite the limitation “a location of relevant markings” in line 2 of claims 3, 11, 19 and 27 after the limitation “a location of relevant markings” was claimed in line 2 of the respective parent claims 2, 10, 18 and 26. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** “location of relevant markings” or ***a unique and distinctly different*** “location of relevant markings” within these claims.

6. **Claims 5, 7, 13, 15, 21, 23, 29 and 31** recite the limitations “a paper document” (line 2 of claims 5, 7, 13, 21, 23 and 31 and line 3 of claim 15 and 29) after the limitation “a paper document” was claimed in the respective parent claims (line 3 of claims 1, 17

and 25 and line 2 of claim 9). The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** "paper document" or ***a unique and distinctly different*** "paper document" within these claims. All claims dependent upon these claims suffer the same deficiency and, therefore, are objected to as well.

7. **Claims 7 and 23** recites the limitation "an image generating device" in line 3 of both claim after the limitation "an image generating means" was claimed in line 2 of the respective parent claims 1 and 17. The applicant has failed to particularly point out and distinctly claim if the applicant is referring to ***the same, instant*** "image generating device" or ***a unique and distinctly different*** "image generating device" within these claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 1 – 8 and 17 – 24** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Regarding **claims 1 – 4, 8, 17 – 20 and 24**, the phrases "adapted to" and "adapted for" render the claim indefinite because it is unclear whether the limitations

following the phrase are part of the claimed invention. See MPEP § 2173.05(d), 2111.04.

Description of examples or preferences is properly set forth in the specification rather than in the claims. If stated in the claims, examples and preferences may lead to confusion over the intended scope of a claim. See MPEP 2173.05(d).

The phrase "adapted to" or "adapted for" is language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure; therefore, it does not limit the scope of a claim or claim limitation. See MPEP 2106 II (c).

Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function. See MPEP 2106 II (c).

The Applicant discloses several preferred embodiments wherein the certain functions are carried out "by any suitable means" such that the claimed means cannot be clearly correlated to the elements set forth in the written description that perform the recited step or function (see *Specification* [page 4, lines 4, 13 – 14, 18 – 19, 21, 28, page 5, lines 6, 8, 10 – 13, 20, 26, page 6, lines 2, 4, 7 – 8, 13, 16, 18, and 26]).

All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected as well.

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. **Claims 1 – 32** are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

Claims 1 – 32 are drawn to **practical applications** that DO NOT produce a useful, concrete and tangible result.

In determining whether the claim is for a “practical application,” the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the **final result achieved by the claimed invention** is “useful, tangible and concrete.” AT&T, 172 F.3d at 1358, 50 USPQ2d at 1451.

The tangible requirement does not necessarily mean that a claim must be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that **the process claim must set forth a practical application of that §101 judicial exception to produce a real-world result.** Benson, 409 U.S. at 71-72, 175 USPQ at 676-77.

13. **Claims 17 – 32** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 17 and 25 are drawn to non-functional descriptive material. MPEP 2016.IV.B.1(a) (Nonfunctional Descriptive Material) states:

"Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101."

"Where certain types of descriptive material, such as music, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing process performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer."

"For example, music is commonly sold to consumers in the form of a compact disc. In such cases, the know compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture."

MPEP 2106.IV.B.1 (Nonstatutory Subject Matter) states:

"When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement."

Claims 17 and 25 currently recite a computer-readable medium and a computer-implemented method, respectively. There is no functional relationship imparted upon the computer-readable medium by a computing device of claim 17, and conversely, there is no functional relationship imparted to the computer-implemented method without a computing device executing a computer program stored on a computer-readable medium of claim 25. Therefore, the claims are drawn to non-functional descriptive material which is non-statutory per se. The fact that the claims recite a computer readable medium does not provide utility (i.e., practical application in the technological arts) required under 35 U.S.C. §101 for the manufacture.

Furthermore, **claims 25 – 32** are drawn to functional descriptive material NOT claimed as residing on a computer readable medium. See MPEP 2106.01 (Functional Descriptive Material) which states:

"Data structures not claimed as embodied in a computer-readable medium are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer."

"Such claimed data structures do not define any structural or functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structures' functionality to be realized."

Claim 25, while defining a computer-implemented method, does not define a "computer-readable medium" and is thus non-statutory for that reason. A computer-implemented method can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

"In contrast, a claimed computer-readable medium encoded with the data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory." – MPEP 2106.IV.B.1(a)

All claims dependent upon these claims suffer the same deficiencies and, therefore, are rejected as well.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. ***Claims 1 – 32*** are rejected under 35 U.S.C. 102(e) as being anticipated by

Bobrow et al. (U.S. Patent No. 6,856,432).

Referring to **claim 1**, Bobrow discloses a system for processing of electronic documents comprising:

image generating means (see *Fig. 1 wherein fax device 50 with scanning capabilities [e.g. CCD] is well-known in the art*) adapted for generating an electronic representation of a paper document (*column 9, lines 35 – 40 wherein a user at fax device 50 places facsimile message 100 as the cover sheet in order to generate the images to be sent*),

the image generating means including means adapted for receiving an associated template sheet (see *Fig. 6, facsimile cover sheet 100 [column 7, lines 58 – 63]*) inclusive of an instruction representative of a desired document processing operation (see *Fig. 6 wherein the user marks check-boxes 102 – 106, which is analogous to an instruction given, to designate processing operations, such as sending an e-mail or sending a fax message [column 8, lines 44 – 49 and column 9, lines 10 – 23]*),

optical recognition means (see *Figs. 1 – 2, e-mail/fax server 20 comprising fax interpreter 25 [column 8, lines 34 – 43 and column 9, lines 49 – 62]*) adapted for recognition of the instruction (*column 8, lines 23 – 43 wherein an application performs OCR operations to interpret the user's handwritten requests and see Fig. 6 wherein fax interpreter 25 uses OCR operations to extract information in data glyphs 108 [column 10, lines 26 – 33]*),

means (see *Fig. 2 wherein processor 21 controls fax interpreter 25 and e-mail interpreter 23 such that the received fax message are converted appropriately [column*

4, lines 41 – 45 and 60 – 65]) adapted for generating an instruction signal in accordance with a recognized instruction (see Fig. 6 wherein the fax device 50 detects the user's marked check-boxes 102 – 106, which designate the desired processing operation [e.g. sending e-mail, sending fax message] [column 8, lines 53 – 57 and column 9, lines 49 – 62]), and

means (see Fig. 2 wherein processor 21 controls fax interpreter 25 and e-mail interpreter 23 such that the received fax message are converted appropriately [column 4, lines 41 – 45 and 60 – 65]) adapted for controlling processing of the electronic representation of a paper document in accordance with the instruction signal (column 9, lines 30 – 35 wherein the fax device 50 sends facsimile message 100 to its intended recipients as designated by the markings of the user).

Referring to **claim 2**, Bobrow discloses the system further comprising means adapted for identifying a location of relevant markings on the template sheet (column 8, lines 23 – 43 wherein an application performs OCR operations to interpret the user's handwritten requests and see Fig. 6 wherein fax interpreter 25 uses OCR operations to extract information in data glyphs 108 [column 10, lines 26 – 33]).

Referring to **claim 3**, Bobrow discloses the system further wherein the means adapted for identifying a location of relevant markings comprised as at least one of check boxes and fill-in boxes (see Fig. 6, check-boxes 102 – 106 [column 8, lines 44 – 49 and column 9, lines 10 – 23]).

Referring to **claim 4**, Bobrow discloses the system further comprising means adapted for optically identifying handwritten characters on the template sheet (*column 8, lines 39 – 48, column 9, lines 10 – 24 and 30 – 35*).

Referring to **claim 5**, Bobrow discloses the system further wherein the instruction signal directs routing of the electronic representation of a paper document in accordance with the instruction as indicated by optically identified handwritten characters (*column 8, lines 23 – 43 wherein an application performs OCR operations to interpret the user's handwritten requests*).

Referring to **claim 6**, Bobrow discloses the system further wherein the routing includes at least one of electronic mail transmission (*see Fig. 6, check-boxes 102 – 104 [column 9, lines 10 – 19]*), facsimile transmission (*see Fig. 6, check-box 106 [column 9, lines 19 – 24]*), FTP transmission, HTML transmission (*column 7, lines 6 – 15 and column 10, lines 35 – 41 wherein the standard file format is HTML*), and optical image rendering on an associated display (*column 10, lines 35 - 41 wherein the standard file formats [i.e. PDF, XTML, GIF, JPEG, etc.] are analogous to an optical image rendering for display purposes*).

Referring to **claim 7**, Bobrow discloses the system further wherein the electronic representation of a paper document is routed to at least one of an electronic mail server (*see Figs. 1 – 2, e-mail/fax server 20*), a document management system (*see Figs. 1 – 2 wherein e-mail/fax server 20 manages system 10 [column 3, lines 20 – 35 and column 4, line 21 – column 5, line 9]*), an image generating device (*see Fig. 1 wherein client machines 30 include display devices [column 3, lines 36 – 52 and column 3, line 66 –*

column 4, line 9]), and an Internet server (see Fig. 1 wherein messages are communicated via network 40 and relayed over the Internet, which is a connected web of servers [column 3, lines 44 – 49 and column 4, lines 10 – 20]).

Referring to **claim 8**, Bobrow discloses the system further comprising verification means (see Fig. 2 wherein fax interpreter 25 constructs the electronic version of the facsimile cover sheet 100 [see Fig. 6] so that it can subsequently inspect to verify proper recipients of the facsimile message) adapted for verifying the desired document processing operation (column 7, lines 38 – 57 and column 8, line 65 – column 9, line 9).

Referring to **claims 9 – 16**, the rationale provided in the rejections of claims 1 – 8, respectively, are incorporated herein. In addition, the systems of claims 1 – 8 perform the methods of claims 9 – 16, respectively.

Referring to **claims 17 – 24**, the rationale provided in rejections of claims 9 – 16, respectively, are incorporated herein. The methods of claims 9 – 16 are stored as programs of instructions of claims 17 – 24, respectively, within memory and executed by a series of processors (column 3, lines 36 – 65, column 4, lines 21 – 38 and column 5, lines 10 – 44).

Referring to **claims 25 – 32**, the rationale provided in rejections of claims 9 – 16, respectively, are incorporated herein. The methods of claims 9 – 16 perform the computer-implemented procedures of claims 17 – 24, respectively, within memory and executed by a series of processors (column 3, lines 36 – 65, column 4, lines 21 – 38 and column 5, lines 10 – 44).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goldstein et al. (U.S. Pre-Grant Publication 2005/0243369) disclose digital electronic versions of printed human-discernible content of a printed document and software which associates the identity of the paper printed with digital pattern with equivalent digital documents (*see Abstract and Fig. 8a*).

Alam et al. (U.S. Patent No. 6,104,500) disclose a processor-based fax routing method wherein digital data representing a facsimile document is received and uses the probabilities computed between the text of the OCR-read name of the addressee and the names in a list of possible addressees, and between the OCR-read keywords and the keywords in a list, the fax routing method determines an addressee for the document (*see Abstract and Figs. 1 – 3 and 5*).

Melen (U.S. Patent No. 6,426,806) discloses a scanning system which routes scanned document information to a specified location based on scanned control sheet information (*see Abstract and Figs. 1 – 3*).

Brown et al. (U.S. Pre-Grant Publication No. 2004/0252330) disclose a method of faxing with a multifunction printer using a control sheet indicative of a set of files accessible by the printer such that the control sheet is optically scanned so as to recognize marks made by a user which indicate which of at least one files have been designated (*see Abstract and Figs. 1 and 4 – 5*).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571) 272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MDR 2/15/08



TWYLER LAMB HASKINS
SUPERVISORY PATENT EXAMINER